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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,356	08/09/2000	Terrence Eugene Sterkel		5710

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PRIEST & GOLDSTEIN PLLC
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EXAMINER

MOORE, JAMES K

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 02/13/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,356

Applicant(s)

STERKEL, TERRENCE EUGENE

Examiner

James K Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 17-24 is/are rejected.
- 7) ☒ Claim(s) 5 and 7-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 25, 2003, with respect to claims 1-4, 20-22 and 24, have been fully considered but they are not persuasive.

Regarding claim 1, in response to applicant's argument that the references fail to show certain features of applicant's invention (see page 15), it is noted that the features upon which applicant relies (i.e., disabling a function on the radiotelephone and transferring performance of a function from the radiotelephone terminal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In regards to applicant's argument that Fuji does not disclose or claim an enhanced services module to "perform the group of non time critical functions upon detection by the basic telephone module of the existence of the enhanced services module", this limitation had been adequately addressed in the rejection in the previous Office Action, and the rejection has been repeated in this Office Action.

2. The rejection of claims 5 and 7-16 have been withdrawn.

3. Applicant's arguments with respect to claims 6 and 17 have been considered but are moot in view of the new ground(s) of rejection.

4. The indicated allowability of claims 18, 19 and 23 is withdrawn in view of the newly discovered reference(s) to Ishigami (U.S. Patent No. 6,625,445). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuji et al (UK Patent Application No. GB 2251357A).

Regarding claim 1, Fuji discloses a wireless telephone comprising a basic telephone module (radiotelephone terminal unit 31) for establishing a connection to a base station (100) and processing voice and data for communication with the base station. The basic telephone module performs a group of time critical functions (e.g., transmitting and receiving voice communications) for communication with the base station and a group of non time critical functions (e.g., inputting and recalling subscriber information). See page 8, lines 15 through page 9, line 18. The telephone also comprises an enhanced services module (external device 43) that connects with the basic telephone module in order to perform the group of non time critical functions. See page 23, line 15 through page 24, line 8. For the enhanced services module to perform the group of non time critical functions, information must transfer between the basic telephone module and the enhanced services module. It is inherent that the basic

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telephone module must detect the existence of the enhanced services module before it can transfer information to it. The enhanced services module receives data (selecting information) from the basic telephone module, processes the data, and passes processed data (subscriber information) to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity available to receive the data.

Regarding claim 2, Fuji discloses all of the limitations of claim 1, and also discloses that the telephone comprises an interface module (52) for transferring data between the basic telephone module and the enhanced services module. See Figure 4.

Regarding claim 3, Fuji discloses all of the limitations of claim 2, and also discloses that the enhanced services module comprises a processor (control section 70) and a memory (storage unit (46), and it is inherent that the enhanced services module comprises a bus for transferring data between the processor and the memory and for transferring data to and from the basic telephone module through the interface module. See Figure 16.

Regarding claim 4, Fuji discloses all of the limitations of claim 3, and also discloses that the basic telephone module, the enhanced services module and the interface module each include connectors (40, 48) to allow easy connection and disconnection of the basic telephone module to and from the enhanced services module. See Figure 4 and page 10, lines 22-27.

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Regarding claim 20, Fuji discloses all of the limitations of claim 1, and also discloses that the enhanced services module may comprise a keyboard (44). See Figure 2.

Regarding claim 21, Fuji discloses all of the limitations of claim 1, and also discloses that the enhanced services module may comprise a display (45). See Figure 2.

Regarding claim 22, Fuji discloses a wireless telephone comprising an interface module (interface connector 51), an enhanced services module (external device 43) removably attached to the interface module, and a basic telephone module (radiotelephone terminal unit 31) removably attached to the interface module. See Figure 4 and page 10, lines 22-27. The basic telephone module controls scheduling of data transfer between the basic telephone module and the enhanced services module by indicating (by transferring code-converted information to the enhanced services module) when the basic telephone module is ready to receive data (subscriber information). See Figure 9 and page 18, lines 3-17.

7. Claims 17-19, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishigami (U.S. Patent No. 6,625,445).

Regarding claim 17, Ishigami discloses a method of wireless communication comprising connecting a basic telephone module (mobile telephone 10) to an enhanced services module (computer 20), receiving inputs from a user, transferring data between the basic telephone module and the enhanced services module, storing inputs

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(telephone numbers) to perform functions (searches) selected by the user in the absence of communication connection with a base station, transferring subscriber information (phone directory data) from the enhanced services module to the basic telephone module, establishing a connection with a base station, conducting communication functions with the base station using the basic telephone module to perform time critical functions (transmitting and receiving data) and non-time critical functions (functions performed in the production of search tables), and transferring data between the basic telephone module and the enhanced services module as needed to transfer the performance of the non-time critical functions to the enhanced services module. See col. 3, lines 38-57; col. 3, line 66 through col. 4, line 35; col. 4, lines 49-62; and col. 5, lines 17-35.

Regarding claim 18, Ishigami discloses a method of upgrading a wireless telephone comprising connecting an enhanced services module (computer 20) to a basic telephone module (mobile telephone 10). See col. 3, lines 38-47. One of ordinary skill in the art recognizes that the enhanced services module can be connected and removed from more than one basic telephone module. The basic telephone module processes a group of time critical functions (transmitting and receiving) and a group of non-time critical functions (functions performed in the production of search tables). The method also inherently comprises detecting the connection of the enhanced service module, and comprises transferring the processing of the group of non-time critical functions to the enhanced services module. See col. 3, lines 48-57 and col. 5, lines 17-35.

Regarding claim 19, Ishigami discloses a method of upgrading a wireless telephone. The method comprises connecting a basic telephone module (mobile telephone 10) to an enhanced services module (computer 20). See col. 3, lines 38-47. One of ordinary skill in the art recognizes that the basic telephone module can be connected and removed from more than one enhanced services module. The basic telephone module processes a group of non-time critical functions (functions performed in the production of search tables). The method also inherently comprises detecting the connection of the enhanced services module, and comprises transferring the processing of the group of non-time critical functions to the enhanced services module. See col. 3, lines 48-57 and col. 5, lines 17-35.

Regarding claim 22, Ishigami discloses a wireless telephone comprising an interface module (e.g., a cable), an enhanced services module (computer 20) removeably attached to the interface module, and a basic telephone module (mobile telephone 10) removeably attached to the interface module. See col. 3, lines 38-47 and col. 10, lines 16-27. The basic telephone module controls scheduling of data transfer between the basic telephone module and the enhanced services module by indicating when the basic telephone module is ready to receive data when the basic telephone module has data to send to the enhanced service module. See col. 6, lines 48-62.

Regarding claim 23, Ishigami discloses all of the limitations of claim 22, and it is inherent that the basic telephone module detects the presence of the enhanced services module upon the enhanced service module connection to the interface module. When connected, processing of non-time critical functions (functions performed in the

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production of search tables) running on the basic telephone module is transferred to the enhanced services module, thereby allowing more of the basic telephone module's processing to be devoted to time critical functions (transmitting and receiving). See col. 1, line 59 through col. 2, line 5 and col. 5, lines 17-35.

Claim Rejections - 35 USC § 103

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji et al. in view of Boesen (U.S. Patent Application Publication No. US 2001/0027121).

Regarding claim 6, Fuji discloses all of the limitations of claim 4, but does not disclose that the interface module comprises a universal serial bus connection. However, Boesen discloses a wireless telephone (personal electronic device 2) that connects to other devices, providing additional functionality to the wireless telephone, via an interface module (connecting to access port 32) that may comprise a universal serial bus connection. See paragraph 45. One of ordinary skill in the art at the time of the invention recognized that a universal serial bus connection provides rapid transfer of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fuji with Boesen, such that the interface module comprises a universal serial bus connection, in order to provide rapid transfer of data between the basic telephone module and the enhanced services module.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji et al. in view of Dornier et al (U.S. Patent No. 5,579,489).

Regarding claim 24, Fuji discloses a wireless telephone comprising a basic telephone module (radiotelephone terminal unit 31) for establishing a connection to a base station (100) and processing voice and data for communication with the base station. See page 8, lines 15-25. The basic telephone module has a first processor (control section 60) and basic components (keypad 35, radio transmitting unit 39) needed for operation. See Figure 2 and page 11, lines 2-7. It is inherent that the basic telephone module comprises an internal bus to communicate between the processor and the basic components. The basic telephone module performs time critical functions (transmitting and receiving voice data) for communication with the base station. The wireless telephone also comprises an enhanced services module (external device 43, which may be an electronic notebook) that connects with the basic telephone module in order to perform non time critical functions (writing subscriber information to storage unit 46). See page 23, line 15 through page 24, line 8. The enhanced services module has a second processor (control section 70) and inherently has an internal bus to communicate between the processor and other components of the enhanced services module. The enhanced services module receives data (subscriber information) from the basic telephone module and passes processed data (subscriber information) to the basic telephone module during intervals when the basic telephone data has sufficient idle processing capacity available to receive the data. Fuji does not disclose that the enhanced services module has an optional hardware component, or that data is processed by communicating between the second processor and the optional hardware component.

However, Dornier discloses an electronic notebook comprising a processor (11) and an optional hardware component (e.g., a printer). Data is processed by communicating (via internal bus 40) between the processor and the optional hardware component. The optional hardware enhances the functionality of the electronic notebook. See Figure 3; col. 6, lines 30-42; and col. 7, lines 11-20. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fuji with Dornier, such that the enhanced services module has an optional hardware component, such as a printer, and that data is processed by communicating between the second processor and the optional hardware component, in order to enhance the functionality of the enhanced services module.

Allowable Subject Matter

10. Claims 5 and 7-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

1/28/04

JKM

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
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